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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

In re Reissue Application of: Michael E. Reedy and Edward W. Rider, Jr.

Serial Number: 09/677,746

Primary Examiner: Allan R. Kuhns

Filed: October 3, 2000

Group Art Unit: 1732

Patent No.: 5,817,261

Issued: October 6, 1998

For: PROCESS FOR PRODUCING ALKENYL AROMATIC FOAMS USING A
COMBINATION OF ATMOSPHERIC AND ORGANIC GASES AND FOAMS
PRODUCED THEREBY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Sir:

(1) **Real Party in Interest**

The real parties in interest are identified in Appellants' Brief (filed January 27, 2003).

(2) **Related Appeals and Interferences**

There are no related appeals or interferences.

(3) **Status of Claims**

As identified in the Appellants' Brief and attached Appendix, claims 1-50 are pending in the application and stand rejected by the Examiner. Together with the filing of this appeal, the Appellants submitted a draft Revised Reissue Declaration, which the Examiner accepted (Examiner's Answer, p. 2). The Appellants sent a signed Revised Reissue Declaration via facsimile to the Examiner on March 3, 2003 to be filed in the case. As a result, the rejection of claims 1-18 was withdrawn and the Examiner indicated that those claims are now allowable (Examiner's Answer, p. 2). Therefore, Appellants request that prosecution as to those claims be

reopened to permit a Notice of Allowance to be issued. In addition, as explained in the Appellants' Brief (p. 2) and in the Examiner's Answer (p. 7), only the issues involving claims 19-50 remain before the Board of Patent Appeals and Interferences.

(4) **Status of Amendments After Final**

The status of amendments is set out in Appellants' Brief and in the Examiner's Answer.

(5) **Summary of the Invention**

The summary of the invention is set out in Appellants' Brief.

(6) **Issues**

The issues are set out in Appellants' Brief; however, as stated in the Examiner's Answer, and in view of the Revised Reissue Declaration filed March 3, 2003, there are no remaining issues regarding claims 1-18, which the Examiner indicated were allowable.

(7) **Grouping of Claims**

The grouping of the claims is set out in Appellants' Brief; however, as stated in that Brief (pp. 1-2), the Examiner's acceptance of the Revised Reissue Declaration on March 3, 2003 has logically removed claims 1-18 from this appeal and mooted arguments relating to them (as recognized by the Examiner - Examiner's Answer, p. 7). Claims 19-50 remain grouped for purposes of this appeal.

(8) **Claims Appealed**

The claims remaining on appeal (claims 19-50) are contained in the Appendix attached to the Appellants' Brief.

(9) **Prior Art of Record**

There is no prior art relied upon by the Examiner in the rejection of claims 19-50.

(10) **Grounds of Rejection**

The Examiner's grounds for rejection of claims 19-50 are set forth in the Examiner's Answer (pp. 3-4); however, as explained more fully below in section 12(c), Appellants do not agree with certain of the Examiner's characterizations.

(11) **New Grounds of Rejection**

There were no new grounds of rejection in the Examiner's Answer.

(12) **Appellants' Reply to Examiner's Response**

In reply to certain statements in the Examiner's Answer and in addition to the arguments in the Appellants' Brief, Appellants state as follows:

(a) It is incorrect for the Examiner to characterize (p. 5) certain statements by the Appellants' from the amendment and response filed November 26, 2001 as "an admission" of their purpose for such amendments and there is nothing in the record that supports that conclusion. To the contrary, and as set forth in the Appellants' Brief, the purpose of the amendments to claims 19-50 was to make them consistent with the amendments made to claims 1, 10, 17 and 18, *i.e.*, to correct an error in the language of the '261 patent claims (Appellants' Brief, pp. 4-5, *citing* November 26, 2001 Response at pp. 4-5 wherein that purpose was explained).

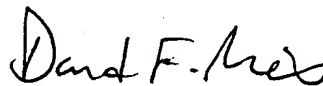
(b) It is also incorrect for the Examiner to imply (p. 6) that Appellants' actions in responding to the restriction requirements of earlier applications indicate acquiescence. To the contrary, and as set forth in the Appellants' Brief (pp. 5-6), the record demonstrates the Appellants did not agree with the Examiner and explained their position regarding the newly-added claims 19-50 by pointing out that they were part and parcel of the same invention as the patented process claims.

(c) It is incorrect as well for the Examiner to refer to "applicant's failure to timely file a divisional application" (Examiner's Answer, Grounds for Rejection, p. 4) as the error upon which the reissue declaration was based. As set forth in Appellants' Brief (pp. 5-6), the reissue declaration dated November 26, 2001 indicates the error as "claiming more than we had a right to claim." Appellants repeatedly stated the claims should be examined together and explained the relationship of the newly-added claims 19-50 to the process claims of the '261 patent (*Id.*). In addition, as set forth in Appellants' Brief (pp. 6-8), the *Orita* case cited by the Examiner is not determinative because, *inter alia*, it is distinguishable from the present case in at least one "crucial" aspect --- the Appellants did not agree to independent prosecution of the disputed claims. However, similar to the reissue claims in the *Doyle* case (cited by Appellants), the newly-added claims 19-50 should have been prosecuted together with the claims of the original application, as clearly indicated by the Appellants in response to the Examiner's requirement of independent prosecution of the claims (Appellants' Brief, pp. 6-8).

(13) Conclusion

For the above reasons, and in addition to those set forth in Appellants' brief, the Examiner's rejection of claims 19-50 should not be sustained.

Respectfully submitted,



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